

REMARKS

The Office Action mailed August 15, 2008 has been carefully considered. Within the Office Action Claims 1-13, 17 and 18 have been rejected; and Claims 14-16 have been objected to. The Applicants have amended Claims 1, 3, 12 and 13. In addition, the Applicants have added new Claims 19 and 20. No new matter has been added. Reconsideration in view of the following remarks is respectfully requested.

The 35 U.S.C. § 112, Second Paragraph Rejection

Claims 1-12 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. This rejection is respectfully traversed. However, to expedite prosecution, Claims 1, 3 and 12 have been amended. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 1-13, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 4,800,242 to Yin in view of International Publication No. WO 00/05735 to Sfondrini et al. (hereinafter “Sfondrini”). This rejection is respectfully traversed.

Specifically, the Office Action contends that the elements in the claims are disclosed in Yin except that Yin does not teach a motorized actuation means. The Office Action further contends that Sfondrini teaches a motorized actuation means and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate Sfondrini into Yin in order to reach the claimed subject matter. The Applicants respectfully disagree for the reasons set forth below.

In determining obviousness four factual inquiries must be looked into in regards to determining obviousness. These are determining the scope and content of the prior art;

ascertaining the differences between the prior art and the claims in issue; resolving the level of ordinary skill in the pertinent art; and evaluating evidence of secondary consideration. Graham v. John Deere, 383 U.S. 1 (1966); KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007) (“ Often, it will be necessary . . . to look into related teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.**”) (emphasis added).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). Thus, when considering the whole prior art reference its entirety, portions that would lead away from the claimed invention must be considered. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), See M.P.E.P. 2141.02. Thus, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983).

Yin discloses a spring-powered drive assembly for opening and closing a switch such as one forming part of a high-voltage switch gear apparatus. The apparatus consists of a drive arm 12 which is moveable between two “extreme positions” of vertical (Figure 1) and horizontal (Figure 2). The arm 12 is coupled to a single spring 28 through a means 45 via a stationary drive rod 44, whereby the spring 28, drive rod 44 and means 45 are positioned within a moveable housing 28. When the arm 12 is to be moved from the open to closed position, the housing 28 itself moves in a desired direction 36 or 38 while the means 45 and drive rod 44 initially remain

stationary. The movement of the housing 28 then causes the opposing portions 28A, 28B of the spring 28 to respectively compress and expand. This results in a cumulative directional force applied to the means 45 which then transfers to the rod 44 to push or pull the drive arm 12 to rotate from closed position to the open position, or vice versa.

One skilled in the art combining Yin with Sfondrini would not reach each and every element/limitation in the claims as required to establish a *prima facie* case of obviousness. Contrary to the Examiner's comments, Yin does not disclose two springs, as specifically recited in Claims 1 and 13. Instead, Yin expressly teaches a single spring 28 having two portions 28A and 28B. Applicants have reproduced the discussion of the spring from Yin for the record:

In the case of typical switches used in high-voltage switch gear apparatus, the force required is quite significant, for example on the order of 300 pounds. In order to provide that much actuating force, mechanism 26 includes a **single** heavy-duty straight coil spring 28 disposed within its own housing 30 which is at least partially closed at its extreme top and bottom ends 32 and 34, respectively.

(Yin, Col. 2, Lines 62-66) (emphasis added). Additionally, Yin states,

In addition to housing 30 and its internal straight spring 28, overall actuating mechanism 26 includes a drive rod 44 which is pivotally connected to drive arm 12 as will be seen hereinafter in conjunction with FIG. 5. The drive rod extends coaxially into housing 30 and through a top section 28A of spring 28. The otherwise free end of the drive rod is fixedly secured to the **spring at a point which divides the latter into equal sections, specifically the previously recited upper section 28A and a lower section 28B.**

(Yin, Col. 3, Lines 9-18) (emphasis added). Accordingly, Yin does not disclose two separate springs in which one spring is an opening spring and the other spring being a closing spring, but in fact states that it is a single spring divided into two equal sections. Considering that Yin fails to disclose two separate springs, Yin also fails to teach or suggest the limitation in Claim 1 that the opening spring is configured to urge the set of jointed elements toward the closed position and is also configured to drive the jointed elements toward the open position upon the jointed elements moving past an open dead centre position during opening. This is not

taught in Yin, because one section of the single spring (i.e. 28A) is not capable of urging the jointed elements to the open and closed positions, as recited in Claim 1. Regarding Claim 13, the combination of Yin and Sfondrini does not teach or suggest first and second pre-stressed springs in which at least the first spring is configured to urge the connecting rod toward the first position, wherein movement of the connecting rod past a predetermined dead centre position causes at least the first spring to then urge the connecting rod toward the second position. Accordingly, Claim 1 is patentable over the combination of Yin and Sfondrini.

Claims 2-12 and 17-18 have also been rejected in light of Yin and Sfondrini. However, Claims 2-12 and 17-18 are dependent on Independent Claims 1 and 13, respectively. As stated above, Claims 1 and 13 are allowable over Yin and Sfondrini. Accordingly, Claims 2-12 and 17-18 are allowable for being dependent on allowable base claims.

Allowable Subject Matter

Claims 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-3557. A three month extension fee accompanies this reply.

Respectfully submitted,

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